The only remaining issue is the rejection under 35 U.S.C. §102(e) of Claims 1, 3, 4, 6-11, 13, 14, 16-18, and 20-22 as being anticipated by the present assignee's Byrne et al. patent, specifically pointing to col. 2, lines 8-22 as a teaching of the independent claims (1, 8, 17, and 22).

Among other things, independent Claims 1, 17, and 22 require sending ***priorities and*** associated data access requests to a storage system. The relied-upon section of Byrne et al. discloses that processes within a computer system can have different priorities, with requests for those processes being ordered based on the priorities ***of the processes***. In contrast to Claims 1, 17, and 22, no mention is made in the relied-upon section of Byrne et al. that the priorities are sent with the requests; indeed, a more reasonable inference from the context of Byrne et al. is that the requests come into the system without any accompanying priorities, but only with a request for a particular process that has a priority already pre-assigned to the requested process. Stated differently (and in the context of independent claim 8), it appears from the relied-upon disclosure of Byrne et al. that the order in which data access requests are serviced depends on considerations that are internal to the data storage system (with Claim 8 requiring the ordering to be based at least in part on external considerations). Accordingly, since every claim limitation is not present in the relied-upon section of Byrne et al., it is not an anticipatory reference.

Moreover, Byrne et al. cannot inherently encompass the claims, since to be inherent a limitation must ***necessarily*** be part of a reference, MPEP §2112 (citing In re Robertson). As stated above, the data requests in the relied-upon section of Byrne et al. are not "necessarily" accompanied by priorities, and indeed it appears that they would not need to be, since the requested processes that are resident on the storage system seem to have pre-set priorities at the storage system level.

Applicant notes that Byrne et al. and the present application have the same assignee, and consequently under 35 U.S.C. §103(c) Byrne et al. is not available as obviousness-type prior art (amended 35 U.S.C. §103(c) excludes as prior art commonly-owned patents which qualify as prior art under 35 U.S.C. §102 (e), (f), and (g)).

The examiner is cordially invited to telephone the undersigned for any reason that would advance the present application to allowance.

Respectfully submitted,

John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg